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MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER	
WON, MICHAEL YOUNG	

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERRY FREESTONE,
JIM PAARSMARKT,
and BRIAN BUCKLER

Appeal 2008-006293
Application 09/668,875
Technology Center 2400

Decided: December 18, 2009

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
JEAN R. HOMERE, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-45, which are all the claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellants' invention relates to an electronic message having an attached sound file and a predetermined identifier regarding the nature of the sound file. Spec. 2: 8-11.

Representative Claim

1. An electronic message configured to be communicated between a sender's device and a recipient's device, the electronic message comprising:

a sound file attached to the electronic message; and,

a predetermined identifier, associated with the sound file, that both distinguishes said sound file from other files attached to the message and indicates a course of action to be taken by the recipient's device with said sound file.

Prior Art

Logan	US 5,732,216	Mar. 24, 1998
Agraharam	US 6,085,231	Jul. 4, 2000

Examiner's Rejections

Claims 1-10, 12-19, 21-31, 33-41, 44, and 45 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Logan.

Claims 11, 20, 32, 42, and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Logan and Agraharam.

Claim Groupings

Based on Appellants' arguments in the Appeal Brief, we will decide the appeal with respect to anticipation on the basis of claim 1 alone, and the appeal with respect to obviousness on the basis of claim 11 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

FINDINGS OF FACT

Logan

Logan describes an audio message exchange system (Title).

An audio player 103 (Fig. 1) connects to a host server 101. Upon request of the audio player, the host server transmits a download compilation file 145, which contains files that identify separately stored sharable files. The order and identification of the program files making up an individual playback session are stored in a session schedule file 351 (Fig. 5). The session schedule file contains program identifiers of the program segments to be played during an upcoming session. The player downloads the session schedule file and issues download requests for those identified program segment files which are not already available in the player's local storage. Col. 5, l. 46 - col. 6, l. 8; col. 11, ll. 4-15.

The system can also accept comments from a subscriber during the course of program playback. A comment is saved as a separate file and may be treated as an annotation appended to the playing program record or as an independent program segment. Col. 41, ll. 27-47.

The ability to direct comments to specific people allows the system to provide a function similar to voice mail among subscribers. A comment could also be transmitted as an audio file attachment to an E-mail message.

Files containing annotations and comments may be uploaded to the host. Col. 42, l. 62 - col. 43, l. 15.

PRINCIPLES OF LAW

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

ANALYSIS

Claim 1 -- § 102 over Logan

We agree with the Examiner that claim 1, as broadly drafted, reads on any one of several embodiments that are disclosed in Logan.

Claim 1 recites an "electronic message," which could be a download compilation file as described by Logan. The "electronic message" could also be the E-mail message containing an audio file attachment.

As the Examiner indicates, and contrary to Appellants' arguments, claim 1 recites that a "predetermined identifier" is "associated with" the sound file attached to the electronic message. The claim does not require that the "identifier" is attached to, or part of, the electronic message (e.g., the E-mail message described by Logan).

As the Examiner also indicates, Logan's session schedule file meets the requirements of the "predetermined identifier" as recited in claim 1. The

session schedule file both distinguishes the sound file (e.g., a subscriber comment) from other files attached to the message and indicates a course of action to be taken by the recipient's device with the sound file (e.g., play the comment in the indicated sequence with respect to other sound files or, simply, play it because it is a sound file).

We are therefore not persuaded of error in the Examiner's finding of anticipation with respect to claim 1.

We also note that the "predetermined identifier" that "distinguishes" and "indicates" as claimed does not modify the underlying function of any machine (e.g., the recipient's device).[1] The claim 1 identifier "associated" with the sound file is intended to distinguish the sound file from other files attached to the message and to indicate a course of action "to be taken" by the recipient's device, but the claim is directed to (no more than) an "electronic message." The "predetermined identifier" is thus at most information "associated with" the sound file -- i.e., mere data that does not affect or change the function of any underlying machine in the invention of claim 1.

The "predetermined identifier" of claim 1 is thus non-functional descriptive material -- mere data that is "associated with" a sound file. Appellants' arguments with respect to what the predetermined identifier is to mean or to represent are immaterial and unconvincing. The *content* of non-functional descriptive material is not entitled to weight in the patentability analysis. *See In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) ("Lowry

[1] Moreover, the "predetermined identifier" might be no more than a file name having an extension that indicates the file is an audio file to be played. *See, e.g.*, Spec. 4:1-4; instant claim 5.

does not claim merely the information content of a memory. . . . Nor does he seek to patent the content of information resident in a database."). *See also Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential); *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (informative), *aff'd*, No. 06-1003 (Fed. Cir. Jun. 12, 2006) (Rule 36); *Manual of Patent Examining Procedure* (MPEP) § 2106.01 (Eighth ed., Rev. 7, Jul. 2008).[2]

Claim 11 -- § 103(a) over Logan and Agraharam

Instant claim 11 recites that the attaching of the sound file to an electronic message is performed by "an adjunct" to the sender's device. The Examiner relies on Agraharam for the teaching of the "adjunct" -- an e-mail server. Ans. 9.

Appellants allege there is "no suggestion or motivation" to combine the teachings of Logan and Agraharam (App. Br. 15). Appellants do not, however, address the Examiner's reasoning stated in support of the combination.

Appellants also allege that even if the references were combined, "the present invention would not be realized," and "would not come up with the invention which the applicants conceived." *Id*. Appellants neglect, however, to tell us what is thought to be missing from the combination of Logan and Agraharam.

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[2] Although not separately argued, independent (method) claim 8 associates a "predetermined identifier" with a sound file, with that "identifier" also being non-functional descriptive material. Independent (method) claim 24, not separately argued, goes so far as to set forth the step of "playing the attached sound file in response to the noting of the predetermined identifier," which can be interpreted as a functional operation but which is also a function disclosed by Logan.

We are therefore not persuaded of error in the Examiner's rejection of claim 11.

Conclusion

Being not persuaded of error in the rejection of any claim on appeal, we sustain the Examiner's rejections over the applied prior art.

DECISION

The rejection of claims 1-10, 12-19, 21-31, 33-41, 44, and 45 under 35 U.S.C. § 102(b) as being anticipated by Logan is affirmed.

The rejection of claims 11, 20, 32, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Logan and Agraharam is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

msc

MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO
ONE FINANCIAL CENTER
BOSTON, MA 02111